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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,325	03/22/2000	Nimrod Megiddo	ARC000009US1-IBM	7964

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[REDACTED] EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/533,325	MEGIDDO, NIMROD	
	Examiner Naresh Vig	Art Unit 3629	
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>			
<b>Period for Reply</b>			
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>			
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>06 November 2002</u> .			
2a) <input checked="" type="checkbox"/> This action is <b>FINAL</b> .      2b) <input type="checkbox"/> This action is non-final.			
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
<b>Disposition of Claims</b>			
4) <input checked="" type="checkbox"/> Claim(s) <u>1 - 22</u> is/are pending in the application.			
4a) Of the above claim(s) _____ is/are withdrawn from consideration.			
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.			
6) <input checked="" type="checkbox"/> Claim(s) <u>1 - 22</u> is/are rejected.			
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.			
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.			
<b>Application Papers</b>			
9) <input type="checkbox"/> The specification is objected to by the Examiner.			
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).			
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.			
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.			
<b>Priority under 35 U.S.C. §§ 119 and 120</b>			
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All    b) <input type="checkbox"/> Some *    c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.			
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.			
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.			
<b>Attachment(s)</b>			
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .	
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)	
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .		6) <input type="checkbox"/> Other: _____ .	

## DETAILED ACTION

This is in reference to the response received by the office on 06 November 2002 to the office action mailed on 31 July 2002. Amendments to claims 1, 5, 12 and 16 are acknowledged. Additions of new claims 21 – 22 are acknowledged. There are 22 claims pending for examination.

### ***Response to Arguments***

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, transaction management has been a practice in use prior to the time of invention. For example, business hire account managers or program managers to manage the project and ensure that the milestones are met in a timely manner to meet the terms of the contract, keep all the parties informed of the current status, be a single point of contact for the transfer of information etc.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 6 and 12 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minder US Patent 6,144,943 in view of Gundewar et al. US Patent 6,381,610 hereinafter known as Gundewar and further in view of an article "Electronic Transactions Are The Future, Says NAR President" by Blanche Evans hereinafter known as Evans.

Regarding claims 1, 12 and 16, Minder discloses a method and apparatus including a computer system for managing contract housekeeping services so as to improve the quality and value of the housekeeping services received. The method invention comprises a series of actions in order to generate a grade representative of the quality of housekeeping services. This grade is then used to make at least one decision regarding the management of housekeeping services. The management having an impact upon the physical appearance and maintenance of a given facility.  
(abstract)

Minder's method for using a computer system to manage contract housekeeping services comprising a series of steps. The first step of the method includes storing in the computer system a plurality of variables describing specific housekeeping service tasks. The next step includes defining a plurality of possible performance criteria scores probative of the plurality of variables. The next step includes receiving in the computer system user input operative to select a subset of the plurality of variables which are applicable to housekeeping for a given facility and then receiving in the computer system the actual performance criteria scores for the selected subset of variables. The computer system is then used to process the actual performance criteria scores and to output a grade representative of the quality of housekeeping services. This grade is then used to make at least one decision regarding management of housekeeping services, the management having an impact upon the physical appearance and maintenance of the given facility. The grade may be used to determine compensation for specific housekeeping services. Also, the grade may be used to determine whether or not to continue contract housekeeping services with the specific provider being evaluated. In another aspect, the grade may be used to implement improvements with respect to specific housekeeping service tasks. (col. 2, lines 5 – 29)

Minder does not disclose notification to contracting parties. Gundewar discloses a method for automated project planning. Entry and exit criteria may include milestones approvals, procedure completions, and/or design or production events necessary to enter or exit the particular process (col. 5, lines 58 – 61). Project repository module may generate and initiate electronic mail communication (notification) to team members (col.

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7, lines 33 – 37). Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to notify contracting parties to avoid the contract from becoming unenforceable due to not meeting the contract terms.

Neither Minder nor Gundewar disclose to retrieve information from independent sources. However, Evans states that "The promise of XML is that REALTORS, their clients, and service providers pertinent to the real estate transaction will each be able to communicate with equal ease using the Internet. Just as important, all communication will be password protected to assure the privacy of the client.

Instead of the pieces of the real estate transaction coming together only at closing, they will join at the beginning of the transaction - when the contract is placed in a secured environment on the Internet. Each service provider will work with the REALTOR to provide on-time on-line service delivery and accurate data entry. "

Evans discloses that the way managing the transaction will work is that once a contract has been signed, a password protected transaction file will be placed on the Internet. All parties to the transaction will be able to access and deliver information (information from independent sources) to their protected area. The REALTOR will open the file with the contract. From there, s/he will monitor the other key players, making sure that each performs as they should. The lender will deliver loan approval on-line to the file. The inspector will file his/her report on-line. The title company, or closing agent will set the closing date - on-line. All key players and their information will add their pieces of transaction data at the appropriate times, prompted by the REALTOR. Therefore, it is known at the time of invention to a person with ordinary skill in the art to

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retrieve the information from independent sources to be able to share the information seamlessly, and, to provide the most current status to the parties involved in the transaction.

Also, Minder does not disclose plurality of interconnecting computing devices.

Gundewar disclose the computer to be part of interconnecting computing devices.

Therefore, it is known at the time of invention to a person with ordinary skill in the art to implement the system of interconnected computing devices to make the system accessible at plurality of locations. For example, the system like America Online is accessible from plurality of locations like offices, malls, cyber café etc.

Regarding claim 2, Minder discloses defining a plurality of possible performance criteria scores probative of the plurality of variables. (col2, lines 10 – 12)

Regarding claim 3, Minder does not disclose responding to the event when a criteria is not met. Gundewar disclose that its project repository module may restrict further completion of the particular procedure or subsequent procedures until all templates have completed and submitted, by electronic mail for example, by team members. Project repository module may also automatically process all of such templates and generate a summary template based on the data in each of such

templates. The summary template and team member templates may all be stored in project workspace. (col. 8 line 62 – col. 9, line 3)

Regarding claim 4, Minder does not disclose retrieving information from remote locations. Gundewar discloses that "Communication link may be a dedicated or switched link over a public switched telephone network (PSTN), a satellite link, a microwave link, or other appropriate communications link between clients and server. The components of system may be part of a local area network (LAN), wide area network (WAN), or other suitable network of interconnected computing devices. In a particular embodiment, components in system communicate over the Internet using the World Wide Web (WWW), file transfer protocol (FTP), Telnet, Usenet, Gopher or Archie utility, electronic mail, bulletin boards, or other communication technique. For example, server and clients may maintain and execute a browser or other suitable program for accessing and communicating information addressed by a uniform resource locator (URL) using link (col. 3, lines 9 – 23). Therefore, it is known at the time of applicant's invention to a person with ordinary skills in the art to retrieve information from remote locations to make the system a distributed system and give remote access to the information to its users.

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Regarding claim 5 – 6, 13 – 15 and 19, Minder does not disclose sending reminders and receiving input from users. Gundewar discloses that the project repository module may restrict further completion of the particular procedure or subsequent procedures until all templates have completed and submitted, by electronic mail for example, by team members. Project repository module may also automatically process all of such templates and generate a summary template based on the data in each of such templates. The summary template and team member templates may all be stored in project workspace (col. 8 line 62 – col. 9, line 3). Therefore, it is known at the time of applicant's invention to a person with ordinary skills in the art send reminders (notify parties involved, business prefer sending reminders using electronic mail to log the messages) and receive input (response) from the users to complete tasks and continue further with the project.

Regarding claim 17 – 18 and 20, Minder does not disclose maintaining milestones. Gundewar discloses milestones, approvals, procedure completions, and/or design or production events necessary to enter or exit the particular process (see FIG. 4). Therefore, it is known at the time of invention to a person with ordinary skill in the art to maintain milestones for a project to make the system useful for its users. For example, if the system does not manage the milestones, then the project manager may not want to use the system.

Claims 7 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minder US Patent 6,144,943 in view of Gundewar et al. US Patent 6,381,610 hereinafter known as Gundewar and further in view of an article "Electronic Transactions Are The Future, Says NAR President" by Blanche Evans hereinafter known as Evans and Leymann et al. US Patent 6,122,633 hereinafter known as Leymann.

Regarding claim 7, neither Minder nor Gundewar disclose recording / logging responses for retrieval. Leymann discloses a workflow-management-system (WFMS). WFMSs manage the execution of business processes. These business process typically are performed in a distributed environment. Typically workflow management system write an audit trail. Audit trail contains a record for each major event, such as start or termination of a process or an activity. The audit trail of WFMS represents a huge potential source of information (col. 2, line 65 – col3, line 5). It allows the team members to work independently on different activities. Program and process activities can be associated with a time limit. The time limit specifies how long the activity may take. If the time is exceeded, a designated person is notified. If this person does not react within another time limit, the process administrator is notified. It not only helps to recognize critical situation but also to detect process deficiencies as all notifications are recorded in an audit trail. Therefore, it is known at the time of applicant's invention to a

person with ordinary skills in the art to record and keep track of the information to keep an audit trail.

Regarding claim 8, it is known at the time of applicant's invention to a person with ordinary skill in the art that a project manager or a contract manager goes into idle state (wait state) monitoring time and progress (to avoid delay in the project implementation) until an event has occurred (there is an update status to the project), or, the milestone is not achieved (passed the deadline). (see the uses of Gantt Chart, Microsoft Project (one of the computer tools used by project managers has been commercially available prior to the time of the invention) provide Gantt Charts to its users).

Furthermore, it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Regarding claim 9, it is known at the time of applicant's invention to a person with ordinary skill in the art that a project manager or contract manager is required to notify its clients when a contract has failed because the terms and conditions of the contract were not met by the responsible parties (for example, in a real estate transaction, when the contingency clauses are not met as per the terms of the contract, i.e. it does not

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meet requirements of both parties, it is deemed to have failed to perform and is cancelled).

Furthermore, it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Regarding claim 10, it is known at the time of applicant's invention to a person with ordinary skill in the art that a project manager or contract manager is required to notify its clients when a terms and conditions of the contracts have been satisfied, and, that the contract is a valid and enforceable contract (for example, in a real estate transaction, when the contingency clauses are met as per the terms of the contract, i.e. neither parties have any more contingencies on the contract, it is deemed to be a valid and enforceable contract).

Furthermore, it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

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Regarding claim 11, it is known at the time of applicant's invention to a person with ordinary skill in the art that a project manager or contract manager is required to notify its clients when a milestone is not achieved to fulfill the requirements of the contingencies on the contract. (for example, in a real estate transaction, when there is a delay in meeting a contingency on the contract, the agent will notify their client to inform the delay on a contingency and take the action as per the instructions from their client).

Furthermore, it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Claims 21 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minder US Patent 6,144,943 in view of Gundewar et al. US Patent 6,381,610 hereinafter known as Gundewar and further in view of an article "Electronic Transactions Are The Future, Says NAR President" by Blanche Evans hereinafter known as Evans and website of New York Times hereinafter known as NYTimes.

Regarding claims 21 – 22, neither Minder nor Gundewar disclose the retrieved information to include at least one of weather, prime rate, mortgage rate etc. However, NYTimes discloses system and method to retrieve information from an independent

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source and display for the user. Therefore, it is known at the time of invention to a person with ordinary skill in the art to display information from independent sources to make the system provide information of interest to the user and make the system cost effective by minimizing on the investment otherwise required to provide the information to the user.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. An article "Where Will Real Estate Be In Five Years"
2. Information on Dawsons

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372.

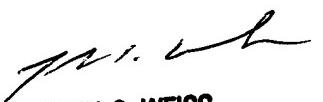
The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

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January 6, 2003

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600